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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,457	12/27/2001	Dennis E. Smith	82987AEK	8364

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,457

Applicant(s)

SMITH ET AL.

Examiner

Walter B. Aughenbaugh

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-19,21,22,24-40,42 and 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2006 has been entered.

Acknowledgement of Applicant's Amendments

2. The amendments made in claims 1, 21 and 42 in the Amendment filed June 16, 2006 (Amdt. F) have been received and considered by Examiner.

WITHDRAWN OBJECTIONS

3. The objection to the specification made of record in paragraph 4 of the Office Action mailed July 1, 2005 has been withdrawn due to Applicant's amendment in claims 1, 21 and 42 in Amdt. F.

WITHDRAWN REJECTIONS

4. The 35 U.S.C. 112, first paragraph rejection of claims 1, 21 and 42 made of record in paragraph 6 of the Office Action mailed July 1, 2005 has been withdrawn due to Applicant's amendment in claims 1, 21 and 42 in Amdt. F.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 112

5. The 35 U.S.C. 112, second paragraph, rejection of claims 1, 21 and 42 made of record in paragraph 8 of the Office Action mailed July 1, 2005 has been repeated for the reasons

Art Unit: 1772

previously made of record. The recitation “after one week... 0.2” does not require that the article has been “expos[ed] to UV light of 50 Klux” over a period of one week.

Claim Rejections - 35 USC § 102

6. The 35 U.S.C. 102 rejection of claims 1, 2, 5, 7, 9-17, 21, 22, 24-26, 28-36 and 39 made of record in paragraph 9 of the Office Action mailed July 1, 2005 has been repeated for the reasons previously made of record. The microbeads have a change in CIELAB value b* of less than 0.2 towards yellowness after one week exposure to UV light of 50 Klux for the same reason that the microbeads have a change in CIELAB value b* of less than 0.2 towards yellowness on exposure to UV light of 50 Klux for one week. Paragraph 9 of the Office Action mailed July 1, 2005.

Claim Rejections - 35 USC § 103

7. The 35 U.S.C. 103 rejections of claims 8, 18, 19, 27, 37, 38, 40, 42 and 43 made of record in paragraphs 10-13 of the Office Action mailed July 1, 2005 have been repeated for the reasons previously made of record.

Response to Arguments

8. Applicant’s arguments presented on page 7 of Amdt. F regarding the 35 U.S.C. 112, second paragraph, rejection of claims 1, 21 and 42 have been fully considered but are not persuasive. The recitation “after one week... 0.2” does not require that the article has been “expos[ed] to UV light of 50 Klux” over a period of one week, so the recitation “after one week... 0.2” is also a conditional limitation.

9. Applicant’s arguments presented on pages 8-11 of Amdt. F regarding the 35 U.S.C. 112, second paragraph, rejection of claims 1, 21 and 42 have been fully considered but are not

Art Unit: 1772

persuasive. Applicant's arguments do not address the basis of the rejection: that CIELAB is a trademark. Applicant has not disputed that CIELAB is not a trademark. Applicant has not shown, for example, that the 1976 CIELAB scale, that Applicant mentions, is the same as the CIELAB scale used by Applicant, and has therefore not addressed the basis of the rejection.

10. Applicant's arguments presented on pages 11-14 of Amdt. F regarding the 35 U.S.C. 102 rejection have been fully considered but are not persuasive.

Applicant has not shown that the samples listed in Table AF-1 are indeed samples of Maier et al. The data for the second sample supports the Office's rejection. Applicant has not explained how the samples listed in Table AF-1 address the rejection of record. Applicant has not addressed the basis of rejection of record regarding the claimed amount of styrenic monomers.

Applicant has not shown that the samples listed in Table AF-2 are indeed samples of Maier et al.: for example, all the samples in Table AF-2 are identified as "Comparative" samples, which would not be samples of Maier et al. Applicant has not explained how the samples listed in Table AF-2 address the rejection of record. Applicant has not addressed the basis of rejection of record regarding the claimed amount of styrenic monomers.

11. Applicant's arguments presented on pages 14-19 of Amdt. F regarding the 35 U.S.C. 103 rejection of claims 18, 19, 37 and 38 have been fully considered but are not persuasive.

Applicant's statement in the third full paragraph of page 15 of Amdt. F does not appear to argue anything other than what was argued earlier in pages 11-14 of Amdt. F in response to the 35 U.S.C. 102 rejection.

Applicant's statement in the fourth full paragraph of page 15 of Amdt. F, and Applicant's presentation of the table at the top of page 16 of Amdt. F, does not address the rejection of record.

Applicant's statement on page 16 of Amdt. F that "[t]he thermal stability for a 5% crosslink monomer, per the examples of Maier, has not been measured" indicates that Applicant has not addressed the rejection of record regarding the thermal stability limitation. Applicant's statement that "... would not be expected..." is speculation, and Applicant has not explained how a discussion of a "sample with 10% crosslink monomer" addresses the rejection of record.

In response to Applicant's arguments on page 17 of Amdt. F, Applicant has not provided any basis for Applicant's "extrapolation of actual test data". Applicant has not provided any basis for an expectation that the extrapolation is correct. Applicant's attempt to explain what was meant by "predict" further supports the position of the Office: "testing" on "a particular combination" must be performed to determine the thermal stability of the "particular combination". Applicant has not provided any basis for an expectation that "once at least two data points of a composition, varying the amount of crosslink monomer, have been determined to establish a line, and hence, a trend, predictions... crosslinking monomer." For example, two experimental points on a graph cannot conclusively establish a "line" (a linear relationship between the x and y values of the graph) that would enable one of ordinary skill in the art to extrapolate with any certainty.

Applicant's argument in the last full sentence of page 18 of Amdt. F does not address the rejection of record.

Art Unit: 1772

12. Applicant's arguments presented on pages 19-22 of Amdt. F regarding the 35 U.S.C. 103 rejection of claims 8 and 27 have been fully considered but are not persuasive.

Applicant's statement in the first full paragraph of page 21 of Amdt. F does not appear to argue anything other than what was argued earlier in pages 11-14 of Amdt. F in response to the 35 U.S.C. 102 rejection. Applicant's statement regarding the amount of styrenic monomers does not address the rejection of record.

Applicant's statement that "it is difficult to predict in advance, without analyzing actual formulations..." further supports the position of the Office: "analyzing actual formulations" must be performed to determine the thermal stability of the "actual formulations".

Applicant's statement regarding the amount of styrenic monomers does not address the rejection of record.

13. Applicant's arguments presented on pages 22-24 of Amdt. F regarding the 35 U.S.C. 103 rejection of claim 40 have been fully considered but are not persuasive.

Applicant's statement in the paragraph bridging pages 22 and 23 of Amdt. F does not appear to argue anything other than what was argued earlier in pages 11-14 of Amdt. F in response to the 35 U.S.C. 102 rejection. Applicant's statement regarding the amount of styrenic monomers does not address the rejection of record. Applicant's arguments on page 24 of Amdt. F depend upon Applicant's arguments in response to the 35 U.S.C. 102 rejection, which have been addressed above in this Office Action.

14. Applicant's arguments presented on pages 25-28 of Amdt. F regarding the 35 U.S.C. 103 rejection of claims 42 and 43 have been fully considered but are not persuasive.

Art Unit: 1772

Applicant's statement in the paragraph bridging pages 26 and 27 of Amdt. F does not appear to argue anything other than what was argued earlier in pages 11-14 of Amdt. F in response to the 35 U.S.C. 102 rejection. Applicant's statement regarding the amount of styrenic monomers does not address the rejection of record. Applicant's arguments on pages 27 and 28 of Amdt. F depend upon Applicant's arguments in response to the 35 U.S.C. 102 rejection, which have been addressed above in this Office Action.

Conclusion


15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
08/04/06

WBA


JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
8/4/06